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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,669	07/07/2003	Todd Jack Olson	10043-010006	7337

26161 7590 04/30/2004

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EXAMINER	
DUNN, DAVID R	

ART UNIT	PAPER NUMBER
3616	

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,669	OLSON ET AL.	
	Examiner	Art Unit	
	David Dunn	3616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/7/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed 7/7/2003 is acknowledged. See enclosed IDS form.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 10-21 and 25-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 15-21 of U.S. Patent No. 6,588,771. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent include all of the limitations of the instant application. For example, claim 1 of patent '771 includes all of the limitations of claim 10 of the application, the patent also claims one extra wheel. Claim 10 of patent '771 includes all of the limitations (toe portion with guide track, fastening member, etc.) of the application with the exception of the cuff portion. However, it is noted that cuff portions are typically found in skate boots, and it would have been obvious to include a cuff portion, including a pivotally attached

cuff portion. Claim 15 of patent '771 includes all of the limitations of claim 25 of the application, with the exception of the frame for the wheels. However, it is noted that frames for attaching wheels are old and well know and typical in an in-line skate, and it would have been obvious include a frame.

4. Claims 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 8 of U.S. Patent No. 6,471,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent include all of the limitations of the instant application. Claims 1 and 8 include all of the limitations of claim 22 of the application; the patent claims are narrower as they include the liner's tongue.

5. Claims 22-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,050,574. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent include all of the limitations of the instant application. Claim 1 includes all of the limitations of claim 22 of the application; the patent claims are narrower as they include the liner's tongue.

6. Claims 10, 12, and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12, 14, and 15 of U.S. Patent No. 6,471,219. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent include all of the limitations of the instant application. Claim 12 includes all of the limitations of claim 10 of the application including the single fastening member securing the toe portion to the frame relative to the heel portion.

7. Claim 22 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8 of U.S. Patent No. 5,678,833. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent include all of the limitations of the instant application. Claim 8 includes all of the limitations of claim 22 of the application; the patent claims are narrower as they include the liner's tongue.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 10, 12, 13, and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu (5,184,834).

Yu discloses an adjustable fit in-line skate comprising: a frame (11) having two spaced-apart, substantially parallel rails (inherent; see Figure 11); a plurality of in-line skate wheels secured between the rails, the inline skate wheels including front wheel, an intermediate wheel, and a rear wheel (see Figure 11); a boot (see Figures 4 & 7) including a heel portion (2) and a toe portion (1); the toe portion being slidable relative to the heel portion along a line of travel generally parallel to a longitudinal axis of the skate (see column 3, lines 1-6; figure 4); the heel portion being generally fixed longitudinally position relative to the frame (by 211); and a single fastening member (31; see Figure 4) releasably securing the toe portion relative to the frame in a desired longitudinal position relative to the heel portion (front rivet 31 can be loosened to extend

the toe portion only). The fastening member extends through a frame opening defined by the frame at a location between the rails (the middle location of the rivet is inherently between the rails). The fastening member extends through an elongated opening defined by a base of the toe portion, the elongated opening (30) being elongated in a direction generally parallel to the longitudinal axis of the skate. The heel includes a sole and side walls that are integrally connected as a single piece (inherent; see Figures 5-8). The fastening member is vertically oriented (see Figures 4 & 7). The heel is generally fixed relative to the frame (see Figure 6).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu alone.

Yu is discussed above and fails to show the fastening member position between the first and second axles or the fastening member being a bolt.

Regarding claim 11, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the location of the fastener or the wheels such that the fastener lined up in a particular position such as between the front two wheel axles as it has generally been recognized that the rearrangement of location of parts involves only routine skill

in the art; *In re* Japikse, 86 USPQ 70. Also, applicant has not disclosed that having the fastener at this particular location is for any particular purpose.

Regarding claim 14, it would have been obvious to one of ordinary skill in the art at the time the invention was made to exchange the rivet for a bolt in order to provide a fastener that could be more easily loosened. Note that Yu states "a rivet (31) or other means" (column 3, line 4); the examiner also takes Official Notice that the use of a bolt as a fastener in a skate is old and well known in the art.

12. Claims 19, 21, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Pullen (3,007,706).

Yu is discussed above and fails to show the sole of the heel portion extending into said toe portion being arranged to resist lateral movement of the toe portion or two surfaces arranged to transmit lateral forces.

Pullen teaches an adjustable skate with a heel portion (84; Figure 2) sole extending into the toe portion (12) and being arranged and configured to resist lateral movement of the toe portion as the toe portion is slid relative to the heel portion (in slot 88). A first surface (side edge of 84) is fixed in position to the heel section and a second surface (sides of slot 88) is fixed in position with respect to the toe section, the second surface being arranged so that the lateral forces exerted on the toe section are transmitted tot eh heel section through the contact between the surfaces (the side surfaces are in contact as seen in Figure 2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yu with the teachings of Pullen to provide the skate with the sliding connection in order to have a simplified and sturdier connection between the heel and toe sections.

Regarding claim 26, it would have been obvious to one of ordinary skill in the art at the time the invention was made to exchange the rivet for a bolt in order to provide a fastener that could be more easily loosened. Note that Yu states "a rivet (31) or other means" (column 3, line 4); the examiner also takes Official Notice that the use of a bolt as a fastener in a skate is old and well known in the art.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Hoshizaki (5,397,141).

Yu is discussed above and fails to show a cuff portion pivotally connected to the heel.

Hoshizaki teaches a skate boot including a cuff portion (5) that is pivotally (see Figure 4) connected to the heel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yu with the teachings of Hoshizaki to provide the skate with a pivoted cuff in order to have a more comfortable boot.

14. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yu in view of Pullen and in further view of Hoshizaki.

The combination of Yu and Pullen is discussed above and fails to show a cuff portion pivotally connected to the heel.

Hoshizaki teaches a skate boot including a cuff portion (5) that is pivotally (see Figure 4) connected to the heel.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Yu and Pullen with the teachings of Hoshizaki to provide the skate with a pivoted cuff in order to have a more comfortable boot.

Allowable Subject Matter

15. Claims 22-24 would be allowable upon the submission of a proper terminal disclaimer as discussed above.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Dunn whose telephone number is 703-305-0049. The examiner can normally be reached on Mon-Thur, alt. Fridays, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 703-308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Dunn
Primary Examiner
Art Unit 3616